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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,184	09/23/1999	RANDALL S. ALBERTE	CEA-003.01	1334
25181 7590 06/25/2009 FOLEY HOAG, LLP PATENT GROUP, WORLD TRADE CENTER WEST 155 SEAPORT BLVD BOSTON, MA 02110				
EXAMINER				
SOROUSH, ALI				
ART UNIT		PAPER NUMBER		
1616				
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06/25/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/406,184

Applicant(s)

ALBERTE ET AL.

Examiner

ALI SOROUSH

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34 and 115-117 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34 and 115-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C2)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The Notice of Allowance of 04/10/2009 is hereby withdrawn because the Terminal Disclaimers filed on 10/24/2008 were not approved for not being signed by an Attorney of record in this application.

Acknowledgement of Receipt

Applicant's response filed on 10/24/2008 to the Office Action mailed on 06/24/2008 is acknowledged.

Status of the Claims

Claims 1-33 and 45-114 are cancelled. Therefore, claims 34 and 115-117 are currently pending examination for patentability.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. The rejection of claims 34 and 115-117 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7087661 B1 **is maintained**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claims a coating composition comprising an antifouling compound of structure 1 and further wherein the coating comprises vinyl polymer, acrylic polymer, phenolic resin, epoxy resin, polyamide resin, vinyl resin, elastomeric polymer, wax, polyester, acrylate polymer, polyurethane, latex, flouropolymer, or silicone coating. U.S. Patent No. 7087661 B1 teaches a coating comprising the same antifouling compounds and further comprising phenolic resin, silicone polymer, epoxy resin, polyamide resin, vinyl resin, elastomer, acrylate polymer, silicone resin, polyester, chlorinated rubber, polyurethane, latex, or fluoropolymer. Although, U.S. Patent No. 7087661 B1 does not teach the use of vinyl polymer, acrylic polymer, wax or silicone coating in the coating composition it would have been obvious to one of ordinary skill in the art to use these as they are well known compounds found in coating compositions. For the foregoing reasons the instant composition would have been obvious to one of ordinary skill in the art in light of claim 1 of U.S. Patent No. 7087661 B1.

2. The rejection of claims 34 and 115-117 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 7108861 B1 **is maintained**. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claims a

coating composition comprising an antifouling compound of structure 1 and further wherein the coating comprises vinyl polymer, acrylic polymer, phenolic resin, epoxy resin, polyamide resin, vinyl resin, elastomeric polymer, wax, polyester, acrylate polymer, polyurethane, latex, flouropolymer, or silicone coating. U.S. Patent No. 7108861 B1 teaches a coating comprising the same antifouling compounds and further comprising organic polymer, hydrocolloids, lipid, fat, carbohydrate, wax, inorganic oxide, or silicone polymer. Although, U.S. Patent No. 7108861 B1 does not teach the use of vinyl polymer, acrylic polymer, phenolic resin, epoxy resin, polyamide resin, vinyl resin, elastomeric polymer, polyester, acrylate polymer, polyurethane, latex, flouropolymer, or silicone coating in the coating composition it would have been obvious to one of ordinary skill in the art to use these as they are well known compounds found in coating compositions. For the foregoing reasons the instant composition would have been obvious to one of ordinary skill in the art in light of claims 1 and 3 of U.S. Patent No. 7108861 B1.

Response to Applicant's Arguments

Applicants have submitted Terminal Disclaimers over Patents 70787661 and 7108861. However, the Terminal Disclaimers are not approved as being submitted by an attorney not of record in this application. For the foregoing reasons the instant rejections are maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Soroush whose telephone number is (571) 272-9925. The examiner can normally be reached on Monday through Thursday 8:30am to 5:00pm E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

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Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ali Soroush
Patent Examiner
Art Unit: 1616

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616